

REMARKS/ARGUMENTS

Claims 1 through 18 are pending in the application.

Applicant's attorneys thank Examiner Nguyen for his courtesy during the telephone conference on August 8, 2006, and for his thoughtful analysis and explanation of the issues. Applicant's attorneys appreciate the invitation by the Examiner to present a written analysis of the claims and references in view of the applicable law. Applicant therefore respectfully submits the following information in support of the Request for Reconsideration, and requests reconsideration and withdrawal of the pending rejections below.

Claims 1 through 9 have been rejected under 35 U.S.C. §103(a) as obvious over the article, "Would You Hire This Person Again?: How to check a job applicant's references. The process is aggravating, but worth it," *Business Week*, pages 32-ENT (June 9, 1997) ("Article 1997"), alone or in view of U.S. Patent Application Publication No. 2002/0120614 to Kelly. Applicant respectfully traverses this rejection for the reasons below.

Independent claim 1 provides a computer-implemented method for determining authenticity of a business partner in response to a request of a user. The method includes: (a) receiving a request of a user to determine authenticity of a business partner; (b) receiving an identity of the business partner from the user; (c) matching the identity of the business partner to a business data record of a business that is one of a plurality of businesses by searching at least one database for the business data record having attributes that match the identity; and (d)

processing one or more of the at least one data attribute of the matched data record according to a set of authentication rules to determine if the business partner is authentic. The data record includes at least one data attribute that represents at least one credential of the business partner.

The primary cited reference, “Article 1997,” describes various manual, human-intensive techniques by which a prospective employer can “pry loose” useful information about a potential job candidate from prior employers, to overcome their reluctance to disclose candid information about the candidate (para. 1). Article 1997 discloses that obtaining a candid reference can be difficult “with companies fearful of lawsuits from ex-employees who receive less-than-glowing reviews” (para. 2). Article 1997 discloses manual, non-automated steps that the employer can take to identify a “cooperative” person in the organization, if the first contact is unwilling to help (paras. 5, 8). Article 1997 teaches the advantage of selecting a senior manager or company owner who knows the candidate because “...executives are more willing to bend the rules” (para. 7). Article 1997 discloses that potential employers should do some “sleuthing” on their own (para. 2) and use the Internet, or Worldwide Web, to verify names and addresses, or alternatively, consider subscribing to a web-based service to provide access to other records, such as criminal and civil court records (para. 4). Article 1997 also teaches hiring pre-employment screening services who provide investigators to check everything about a prospective job candidate, including driving records and bankruptcy filings (para. 4). Article 1997 emphasizes that, to achieve a successful result, the prospective employer should be prepared to “spend as long as 30 minutes on each chat” (para. 9). This is further underscored in Article 1997’s conclusion, “Don’t rush it...talk long enough to get a feel for both the employee and the reference” (para. 12).

The second cited reference, Kelly, discloses a computerized system and method for prospective employers to verify educational claims of an individual who claims to have attended that school, using electronic communication with the educational institution's official records so that the request can be transmitted, and automatically processed, and then a report compiled and transmitted back to the user (para. 11). Kelly discloses that this is most advantageously done where the official student information is accessed only in read-only format (para. 20). The educational claims that are verified by Kelly include enrollment, degree, transcript and other information associated with a student or former student's experience regarding an educational institution (paras. 19 – 20). Such information may be obtained from more than one educational institution with a single inquiry (para. 20).

The applicable rule is that, to establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference(s) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

At the outset, Applicants respectfully submit that the primary reference (Article 1997) fails to teach or suggest all of the claim limitations recited in claim 1 of the present invention.

Claim 1 recites, *inter alia*, a “computer-implemented method,” which is very nearly the exact opposite of the subject matter disclosed in Article 1997, which emphasizes the benefit and advantage of a manual, interactive, person-to-person conversation between a prospective employer and the former employer, for the purpose of obtaining a candid, subjective assessment of the candidate. Article 1997 provides an example of a successful outcome of one such interactive conversation, where a prospective employer learns from a former subordinate that the candidate “is the laziest person in the world” (para. 6). This example is used to show how the interactive conversation yields useful, subjective information well beyond the objective data about the former employee’s service dates and job title. This data is quite distinct from the computer-implemented method for determining authenticity of a business partner recited in claim 1. Article 1997 also teaches that the prospective employer should consider the *quality of the reference* [emphasis added] just as he would the quality of the prospective employee (para. 9), which teaches away from the method of claim 1. This is demonstrated where Article 1997 provides an example where very positive feedback about the former employee still resulted in a no-hire decision because the prospective employer was assessing the quality of the source itself (“after a long discussion, she realized that the qualities valued in the employee – the ability to be a jack-of-all-trades – weren’t the ones required by [the new employer], who needed a detail-oriented person”)(para. 9). Stated another way, Article 1997 teaches that the successful outcome of the discussion was that the prospective employer made the hiring decision in view of the quality of the reference source, rather than solely on information obtained about the job candidate. And though Article 1997 discloses that the prospective employer (or its hired investigators) can search the Internet or Web to verify important facts about the candidate (such

as name, address, court records, etc.), Article 1997 discloses this information-gathering technique as performed by the user in the same way that the skilled artisan might go to the library or courthouse, ask for a book or case file, and find this information by hand. Once again, this method is distinguishable from the “computer-implemented method” recited in claim 1. In this instance, claim 1 provides a feature that distinguishes the claim from the interactive, personal information-gathering methods described in Article 1997.

Further, the two cited references (Article 1997 and Kelly) do not suggest combination, nor do they provide the motivation for obviousness when taken in combination. The mere fact that the two references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). In fact, Article 1997 teaches away from the features of claim 1 by emphasizing the benefits and advantages of the caller setting aside sufficient time (as stated in para. 12, “don’t rush”) to make calls during business hours for purposes of an interactive telephone call. This is distinguishable, and teaches away from, the computer-implemented method recited in claim 1, which is automated for rapid turnaround. Moreover, the purposes of the two cited references (Article 1997 and Kelly), and the problems each reference seeks to solve, are not aligned such that their combination would have been obvious to a person of skill in the art. Specifically, Article 1997’s stated purpose is to suggest techniques for prospective employers to “pry loose” subjective, candid assessments of job candidates from former employers using manual, person-to-person interaction with questions that are tailored to overcome the former employers’ reluctance to respond (for example, “even close-mouthed types might answer the question, ‘would you hire this person again?’” in para. 3).

Kelly, on the other hand, provides a method of using a computer to query educational databases directly, preferably using electronic communication, to verify objective data about the student's records at the school (transcripts, degrees, etc.). An employee of the educational institution only becomes personally involved when the inputted student identifier falls out without producing a match, thereby generating a request for manual search of records. Thus, the two cited references use entirely different principles in order to gather information, and gather diverging types of information. Neither reference expressly or implicitly supports a reason why a person of skill in the art would have been motivated to combine them with a reasonable expectation of success. See MPEP §2143.01.

Steps (a) and (b) of claim 1 specifically recite steps of receiving a request of a user to determine authenticity of a business partner, and receiving an identity of said business partner from said user, respectively. Applicant respectfully submits that Article 1997 fails to teach or suggest a method of authenticating a "business partner," or receiving an identity of said "business partner," as recited in claim 1, and as defined in the specification. The plain meaning of business partner, in the context of claim 1, would be clearly understood by a person skilled in the art, particularly when interpreted in light of the specification that expressly defines the "business partner" relationship by example: "XYZ is a business partner of user, such as supplier, customer, joint venture partner, licensee, licensor, or other business partner" (page 6, lines 6 – 11).

Step (c) of claim 1 recites matching the identity of the business partner to a business data record of a business that is one of a plurality of businesses by searching at least one database for

the business data record having attributes that match the identity, wherein the data record includes at least one data attribute. Applicant submits that Article 1997, alone or in combination with Kelly, fails to teach or suggest matching the step of matching the identity of the business partner to a business data record, where the business data record has attributes such as business name, business location, Dun & Bradstreet (DUNS) number, etc. (page 5, lines 14 – 17). Article 1997 discloses using the Internet or Web to search databases to verify individual names and addresses, and court records, but does not disclose searching a DUNS number or other business information. Nor does Kelly – which discloses searching and confirming educational records such as enrollment, degree, and transcripts using computerized systems – supplement the teaching of Article 1997 to show searching of business records.

Step (d) of claim 1 presents at least two features which are not taught or suggested by Article 1997, when taken alone or in view of Kelly. Specifically, step (d) recites processing one or more data attribute of the matched data record according to a set of authentication rules to determine if the business partner is authentic, wherein the at least one data attribute represents at least one credential of the business partner. Applicant respectfully submits that Article 1997 fails to teach or suggest a “set of authentication rules” to determine whether or not the candidate is authentic. The present invention describes the “authentication rules” (represented as 50 in the specification) by example, where one authentication rule can be to check trade references for current trends, and, if there is a current transaction, there is a high probability that the business partner is authentic (page 7, lines 25 and 29 – 30). Instead, Article 1997 teaches away from querying the source according to a set of authentication rules, citing the benefits and improved

prospects of success by querying “executives [who] are *more willing to bend the rules*” (para. 7) [emphasis added]. In the context of Article 1997, “bending the rules” implies going beyond the safe-harbor recitation of service dates and job titles, and into the source’s own subjective assessments of the candidate’s strengths and weaknesses. Article 1997 also teaches away from the present invention in the example provided where very positive feedback still resulted in the rejection of the candidate (para. 9). Kelly’s computerized method of querying an educational institution’s records database, as where the database is preferably in “read-only” format, provides no suggestion or teaching that would have motivated the person of skill in the art to combine Article 1997 with Kelly to recite the claim features recited in step (d).

A second feature of step (d) that is not taught or suggested by Article 1997, whether taken alone or in combination with Kelly, is that the at least one data attributes represents “at least one credential of said business partner.” “Credential” of a business partner would be clear on its face to the person of skill in the art, and is further defined in the specification (by example) as a “license, purchase authority, bank account verification, professional memberships or industry memberships (page 3, lines 19 – 21 and page 8, lines 15 - 17). Negative credentials, such as bankruptcy, fraud indicators, and government debarment also exist (page 8, lines 17 – 18). According to step (d), any such “credentials” are processed according to a set of authentication rules to determine if the business partner is authentic. In contrast, Article 1997 does not teach or suggest a method of subjecting credentials to a set of authentication rules. The second reference, Kelly, discloses a method from a non-analogous art, which is distinguishable in that it does not teach subjecting business credentials to authentication rules.

Thus, for the reasons above, Applicant submits that Article 1997, taken alone or in combination with Kelly, fails to teach or suggest all of the features of claim 1, and, in some instances, teaches away from those features. Accordingly, claim 1 is patentable over the cited references. Applicant therefore respectfully requests reconsideration and withdrawal of the rejection to claim 1 under §103(a).

Dependent claims 2 through 9 also are rejected under §103(a). For at least the reasons presented for independent claim 1 above, Applicant would request reconsideration and withdrawal of the rejections to dependent claims 2 through 9. Further, dependent claims 2 through 9 each have an additional basis for requesting reconsideration and withdrawal of the rejections. Specifically, dependent claim 2 adds the features that the user is notified of the results of the matching in step (c) of claim 1, and that the notifying step and steps (a) through (c) are automatically performed by a computer system either alone or in combination with a user network. The present invention is an automated method, and provides an authenticity report to the user within a rapid turnaround time. In contrast, Article 1997 fails to teach or suggest an automated authentication method, or provide a motivation for the person of skill in the art to combine with Kelly. Article 1997 emphasizes the benefits of a well-prepared, interactive personal telephone conversation, featuring a long turnaround time (“be prepared to spend as long as 30 minutes”) and a concerted effort to locate a “cooperative” person, so that the user gets a “feel” for the quality of the candidate and the reference (para. 9). Dependent claims 3 through 5 add features that a standard template is provided for entry of data for the identity of the business

partner, where the template is presented to the user (claim 4) or business partner (claim 5) for completion. Article 1997 does not teach or suggest the feature of providing a standard template for data entry that is completed by the job applicant or interviewer; instead, Article 1997 starts with the candidate's resume or application (para. 3), and emphasizes the need for the interviewer to perform some verification and "sleuthing" until a cooperative source is located. Article 1997 provides no suggestion that would have motivated the person of skill in the art to combine its teaching with Kelly to develop the features recited in claims 3 through 5, without the benefit of hindsight reasoning. Dependent claim 6 recites the feature that the "authentication rules" require one or more current transactions with trade references. Article 1997 does not teach or suggest this feature anywhere in its disclosure, whether taken alone or in combination with Kelly. Dependent claim 7 recites the feature that a registration template is presented to the business partner for registration in the business database, in the event that the matching step in 1(c) fails to find a match. Applicants would submit that Article 1997, taken alone or in combination with Kelly, provides no feature where the user sends a registration template *to the job candidate* if the matching process fails to turn up a match. Instead, at para. 38, Kelly discloses that, in the event that the user's request for educational records returns a negative response from the student records system, a communication is generated from the user to an employee *at the educational institution* for further processing. Dependent claim 8 recites the additional step of searching the business database for a credential of the business partner, and dependent claim 9 recites that the credential is selected from the group consisting of license, purchase authority, bank account verification, professional memberships and industry memberships. Article 1997, taken alone or in combination with Kelly, does not disclose or suggest the credentials. For at least these

reasons, Applicant would submit that dependent claims 2 through 9 are neither taught nor suggested by Article 1997 taken alone or in combination with Kelly. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejections to claims 2 through 9 brought under §103(a).

Claims 10 through 18 are rejected under 35 U.S.C. §103(a) as obvious over Article 1997, described above, in view of U.S. Patent Application Publication No. 2002/0120614 to Kelly. Applicant respectfully traverses this rejection for the reasons below.

Claim 10 recites a computer system for determining authenticity of a business partner in response to a request of a user comprising: a device for receiving a request of a user to determine authenticity of a business partner; and at least one processor for performing the steps of: receiving an identity of said business partner from said user; matching said identity of said business partner to a business data record of a business that is one of a plurality of businesses by searching at least one database for said business data record having attributes that match said identity, wherein said data record includes at least one data attribute; and processing one or more of said at least one data attribute of said matched data record with at least one business according to a set of authentication rules to determine if said business partner is authentic, wherein said at least one data attribute represents at least one credential of said business partner.

The “Article 1997” and Kelly references, as well as the applicable rule for *prima facie* obviousness, are summarized above and, for brevity, will not be repeated here. Independent

claim 10 recites a “computer system” for determining authenticity of a business partner in its preamble. Applicants respectfully submit that the primary reference (Article 1997) fails to teach or suggest all of claim 10’s features. Claim 10 recites a “computer system,” which is readily distinguishable from the subject matter disclosed in Article 1997, which emphasizes the benefit and advantages of an interactive, person-to-person conversation between a prospective employer and the former employer. The benefits of such interactive conversations are described above in the analysis for claim 1, including the fact that Article 1997 teaches the user to consider the *quality of the reference* [emphasis added] just as he would the quality of the prospective employee (para. 9), which teaches away from the computer system recited in claim 10. In this instance, claim 10 provides a feature that distinguishes the claim from interactive, personal authentication methods such as the telephone calls that are the subject matter of Article 1997.

Furthermore, neither Article 1997 nor Kelly suggests combination with the other, nor does either cited reference provide a motivation for obviousness when taken in combination. The mere fact that the two references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Article 1997 does not suggest a motivation for combining its telephonic interview methods with Kelly’s computerized query of educational institution records. Moreover, the stated purposes of Article 1997 and Kelly, and the problems each reference solves, are not aligned in such a manner that their combination would have been obvious to a person of skill in the art. Specifically, Article 1997’s purpose is to suggest techniques to “pry loose” subjective, candid assessments of job candidates from former

employers by using an interactive and person-to-person, with questions that are tailored to overcome the former employer's reluctance to respond (so that "even close-mouthed types might answer the question, 'would you hire this person again?'" in para. 3). Kelly, on the other hand, provides a method of using a computer to query educational databases directly, preferably using electronic communication, to verify objective data about the student's records at the school (transcripts, degrees, etc.). An employee of the educational institution only becomes personally involved when the inputted student identifier falls out without producing a match, thereby generating a request for manual search of records. Thus, the two cited references use entirely different principles in order to gather information, and gather diverging types of information. Neither reference expressly or implicitly supports a reason why a person of skill in the art would have been motivated to combine them with a reasonable expectation of success. See MPEP §2143.01.

Claim 10 also recites "at least one processor" for performing certain steps (receiving... matching... and processing...). The processor, represented by reference number 40 in Figure 2, is part of the computer system operating under the control of an operating system to run the authentication program. Article 1997, while mentioning computers generally, does not disclose a computer processor running an authentication program; instead, this processing, such as it is, is performed by the person placing the call to assess the quality of the information as well as the quality of the source. Although Kelly is drawn to a computerized system, Kelly operates in a non-analogous art; that is, to verify educational records from educational institutions rather than business records which are analyzed by the processor in claim 10. The remaining elements of

claim 10 (receiving...matching... and processing...) are similar to the corresponding steps (a) through (c) recited in claim 1, and are distinguished over Article 1997 and Kelly for the same reasons as provided for claim 1.

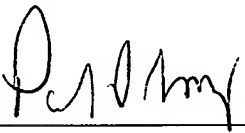
Dependent claims 11 through 18 have also been rejected under §103(a). For at least the reasons presented for the independent claim 10 above, Applicant would request reconsideration and withdrawal of the rejections to dependent claims 11 through 18. In addition, dependent claims 11 through 18 have supplemental bases for being free of the teachings of Article 1997 in combination with Kelly. Specifically, dependent claim 11 recites a notifying means that is used to notify the user of the determination made by the processor. The present invention is thus an automated method using the processor, and provides notification of an authenticity report in a rapid turnaround time. Article 1997, on the other hand, fails to teach or suggest an authentication method using a processor, nor does Article 1997 suggest a reason that would have motivated a person of skill in the art to combine its teaching with Kelly. The reason for this is that Article 1997 emphasizes the benefits of a well-prepared, interactive personal telephone conversation that may require a large investment of time (“be prepared to spend as long as 30 minutes”), rather than a computer system using a processor to run an authentication program for business partners. Dependent claims 12 through 14 add the features that a standard template is provided for entry of data for the identity of the business partner and presented to the user (claim 13) or business partner (claim 14) for completion. Article 1997, when taken in combination with Kelly, does not teach or suggest providing a standard template for data entry that is completed by the job applicant or interviewer. Instead, Article 1997 uses the resume or application (para. 3),

and emphasizes the need for the interviewer to do some “sleuthing” until a cooperative source or reference is located. Article 1997 thus provides no suggestion to have motivated the person of skill in the art to combine its teaching with Kelly to develop the features of claims 12 through 14, without relying on hindsight reasoning. Dependent claim 15 adds the feature that the “authentication rules” require one or more current transactions with trade references. Article 1997 alone, or in combination with Kelly, does not teach or suggest such authentication rules. Dependent claim 16 recites the feature that a registration template is presented to the business partner for registration in the business database, in the event that the matching step recited in claim 10 fails to find a match. Applicants would submit that Article 1997, taken in combination with Kelly, does not provide a feature that if the matching process fails to turn up a match, that the user sends a registration template *to the job candidate*. Instead, Kelly discloses at para. 38 that, in the event that the user’s request for educational records returns a negative response from the student records system, a communication is generated from the user to an employee at the educational institution for manual processing. Dependent claim 17 recites the additional step of searching the business database for the credential of the business partner, and dependent claim 18 recites that the credential is selected from the group consisting of license, purchase authority, bank account verification, professional memberships and industry memberships. Article 1997, taken in combination with Kelly, does not disclose or suggest these specific features. For at least these reasons, Applicant would submit that dependent claims 11 through 18 are free of the cited art. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejections to claims 11 through 18 brought under §103(a).

In view of the above, Applicant respectfully submits that the claimed invention is patentably distinguishable over the cited art, taken alone or in combination. As such, reconsideration and withdrawal of all claim rejections and objections and passage of this application to allowance are respectfully requested.

Respectfully submitted,

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Date



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